

**Notice of Allowability**

Application No.

10/009,613

Examiner

Jennifer R. Sadula

Applicant(s)

UENO ET AL.

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the RCE filed 1/12/2004.
2. ☒ The allowed claim(s) is/are 1-6.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 6
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/12/2004 has been entered.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 7/9/2003 has been considered by the examiner. However, the examiner wishes to note that the reference merely submitted without any English translations of an abstract have only been considered on the merits of that which was in English and no more.

### ***Allowable Subject Matter***

Claims 1-6 are allowed.

The following is an examiner's statement of reasons for allowance:

The closest reference is Kaneko et al., U.S. Patent No. 6,300,459 ("Kaneko")

Applicants claim a liquid crystal polyester resin comprising 1-500 mmol% of a recurring unit which is a residual group of 4-HIP and/or SA based on the total of all the recurring units, an 10-5,000 ppm of an alkali metal.

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Kaneko teaches aromatic polycarbonated having high molecular weight and the process for production of such materials wherein the product of an aromatic polycarbonate and an active-hydrogen compound reaction is further reacted (or treated (2:26-35) with a salicylic acid ester derivative expressed by chemical formula (1) (abstract). A polyester carbonate can be produced by utilizing a dicarboxylic acid derivative in the above process for the production of polycarbonate (5:10-14). Furthermore, Kaneko teaches that low contents of alkali metals existing as impurities in the SA ester derivative are preferable (12:27-31) however, the contents of such impurities are 10 ppm or less for alkali metals (12:32-35). Although there exists overlap at 10ppm, this reference is not considered anticipatory as neither the claimed invention, nor the identity of the invention, are identically disclosed and instead requires picking and choosing among a number of different options *Mendenhan v. Astec Industries, Inc.*, 13 U.S.P.Q.2d 1913, 1928 (Tenn. 1988), *aff'd*, 13 U.S.P.Q.2d 1956 (Fed. Cir. 1989). It is clear from the Applicants' teaching that the alkali metal is not merely at "impurity" levels but is crucial to the desired properties of the invention.

### ***Conclusion***

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer R. Sadula whose telephone number is 571.272.1391.

The examiner can normally be reached on Monday through Friday, 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571.272.1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MARK F. HUFF  
SUPERVISOR, EXAMINER  
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JRS  
2/2/2004